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10/523,316

02/21/2006

Jean-Claude Yvin

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08/01/2006

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EXAMINER

UNDERDAHL, THANE E

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,316

Applicant(s)

YVIN ET AL.

Examiner

Thane Underdahl

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/13/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 provide for the use of an aqueous ionic solution for rinsing contact lenses, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

In the interest of compact prosecution, these "Use" claims will be examined as composition claims and alternatively as method of use claims. There are two separate rejections below.

The phrase "point of view" in claim 1 and 2, is queried since it does not clearly define the characteristics or references that are being considered in the claims. Similarly, the phrase "from the ionic point of view" is unclear since it is not an art recognized phrase to describe ion concentration or solution. Clarification is required.

Claim Rejections

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yvin et al. (WO 01/49304). This WIPO document is the PCT that corresponds to the US patent publication US 2003/0152645. For the purposes of examination this US patent publication will be used as the translation of the WIPO document and all references will be directed to the US patent publication.

5. These claims are drawn to a composition of aqueous ionic solution obtained from seawater.

6. The table below diagrams the teaching of Yvin et al., and which claims they are drawn to.

| Yvin et al. teach | Claims | Reference |
|--|---------|-----------------|
| A composition for the eye that is obtained from sea water | 1 and 2 | Abstract |
| A pH range between 4 and 9 and osmolarity between 150 to 700 | 1 | Abstract |
| A composition with a pH equal to or less than the lowest pH of seawater with salt concentration ranges that are identical to claim 2 | 2 | Page 4, claim 5 |

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yvin et al. (WO 01/49304) in view of Bawa et al. (U.S. Patent # 4,931,279).

9. These claims are drawn to a method to use an aqueous ionic solution obtained from seawater to rinse contact lenses.

10. Yavin et al., as mentioned above (see table), teach a solution of claims 1 and 2. Yavin et al. further teach that the solution can be used "for treating and cleaning the eye and all its appendages" (page 4, claim 1) and "in the form of lotions intended to for washing the eye, in the form of collyria, ophthalmological gels, or to replace the water in ocular inserts" (pg3, paragraph 84). Yavin et al. does not specifically teach the use of their solution for rinsing contact lenses.

11. However Bawa et al. teach that contact lenses can alternatively act as ocular inserts (col 12, claim 6). Also, a person of ordinary skill in the art would recognize that clean contact lenses are imperative to good eye hygiene and that a solution that is useful for directly cleaning the eye would also be useful for rinsing contact lenses.

12. It would therefore have been obvious for the person of ordinary skill in the art to use the composition of Yvin et al. to rinse contact lenses. The motivation is provided by

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Yavin et al. and Bawa et al. with the reasonable expectation of success provided by Bawa et al, who show that contact lenses can be an alternative to ocular implants.

13.

In summary, all claims are anticipated or rendered obvious by the prior art and no claims, as written, are allowed for this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thane Underdahl whose telephone number is (571) 272-9042. The examiner can normally be reached on 8:00 to 17:00.

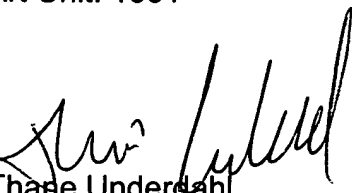
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

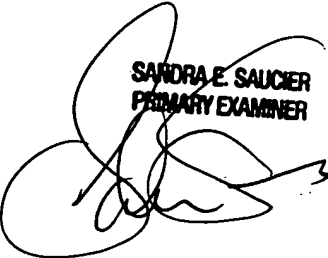
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Thane Underdahl
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SANDRA E. SAUCIER
PRIMARY EXAMINER